

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte FUMIN LU

Appeal 2006-2618
Application 09/778,454
Technology Center: 1700

Decided: September 27, 2006

Before WARREN, WALTZ, and TIMM, *Administrative Patent Judges*.

WARREN, *Administrative Patent Judge*.

REMAND TO THE EXAMINER

We remand the application to the Examiner for consideration and explanation of issues raised by the record. 37 C.F.R. §41.50(a)(1) (2005); Manual of Patent Examining Procedure (MPEP) § 1211 (8th ed., Rev. 3, August 2005).

The record shows that the Examiner advanced on appeal separate grounds of rejection for each of appealed claims 1, 3, 5, 7, and 8, each ground involving a different reference or references, under 35 U.S.C.

§§ 102(b) or 103(a) in the alternative or under the latter statutory provision alone (Answer 3-8).

Appellant addressed the grounds of rejection in the Amended Appeal Brief (Amended Br. 5-11) which arguments were addressed by the Examiner (Answer 8-12).

However, in the Reply Brief, Appellant submitted significant additional arguments with respect to each ground of rejection (Reply Br. 2-12). These arguments are directed at the specific limitations in the claims and the basic factual underpinning of the Examiner's grounds of rejection with respect thereto. The Examiner entered the Reply Brief but did not respond to the arguments (Office action mailed July 13, 2006). To the extent that a prima facie case of obviousness had been made out by the Examiner over the references as applied in the grounds of rejection advanced in the Answer, the new factual arguments by Appellant in the Reply Brief shifted the burden back to the Examiner to again establish the factual underpinning of a prima facie case under 35 U.S.C. §§ 102(b) and 103(a) as applied on the record as a whole in order to maintain the grounds of rejection. *See generally, In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

Furthermore, appealed claims 1 and 5, drawn in product-by-process format, *see generally, In re Thorpe*, 777 F.2d 695, 697, 227 USPQ 964, 966 (Fed. Cir. 1985), contain the limitation "generating a filament speed above 4,000 meters per minute." The Examiner has not taken into consideration this limitation and the properties of fabric produced by a process containing this step to the extent disclosed in the written description in the

specification by Appellant (Answer 3-4, 7, and 9). It is well settled that in order to establish a prima facie case of anticipation under § 102(b) and of obviousness under § 103(a) over the applied prior art, all of the claim limitations must be considered. *See, e.g., In re Geerdes*, 491 F.2d 1260, 1262-63, 180 USPQ 789, 791-92 (CCPA 1974) (In considering grounds of rejection “every limitation in the claim must be given effect rather than considering one in isolation from the others.”).

Accordingly, the Examiner is required to take appropriate action consistent with current examining practice and procedure to prepare a Supplemental Answer for the purpose of specifically responding to the new arguments presented by Appellant in the Reply Brief and to consider the claim limitation discussed above in connection therewith, with a view toward placing this application in condition for decision on appeal with respect to the issues presented.

This remand is made for the purpose of directing the Examiner to further consider the grounds of rejection. Accordingly, if the Examiner submits a Supplemental Answer to the Board in response to this Remand, “appellant must within two months from the date of the supplemental examiner’s answer exercise one of” the two options set forth in 37 C.F.R. § 41.50(a)(2) (2005), “in order to avoid *sua sponte* dismissal of the appeal as to the claims subject to the rejection for which the Board has remanded the proceeding,” as provided in this rule.

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We hereby remand this application to the Examiner, via the Office of a Director of the Technology Center, for appropriate action in view of the above comments.

REMANDED

CFW/tf

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